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VEDDER PRICE KAUFMAN &
KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

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APR 14 2006

OFFICE OF PETITIONS

In re Patent No. 6,911,989 :
Peyman Hojabri : DECISION ON REQUEST FOR
Issue Date: June 28, 2005 : RECONSIDERATION OF
Application No. 10/622,613 : PATENT TERM ADJUSTMENT
Filed: July 18, 2003 :
Atty Docket No. P05619(11461. :
00.0175) :

This is a decision on the "PETITION TO CORRECT PATENT TERM ADJUSTMENT," filed August 29, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from eleven (11) days to one hundred thirty-one (131) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On June 28, 2005, application No. 10/622,613 matured into Patent No. 6,911,989. The instant request for reconsideration filed Monday, August 29, 2005, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with

a revised Patent Term Adjustment of 11 days. The PTA of 131 days was reduced by 120 days pursuant to 37 CFR § 1.704(c)(10) for the submission of drawings after the mailing of the notice of allowance.

Patentee acknowledges submitting replacement sheets of drawings after the r of the notice of allowance on January 27, 2005. However, patentee asserts that the assigned should not be penalized with a reduction pursuant to § 1.704(c)(10) in this case. Patentee states that the only change to the drawings filed on February 25, 2005, was that words the "(Prior Art)" were added to Figures 1 and 2. Furthermore, this change was made per the request of the examiner in the Notice of Allowability and was required to avoid abandonment of the application. However, no provision of the Patent Act of the Code of Federal Regulations requires the action required in the Notice.

Patentee's arguments have been considered, but are not persuasive. The submission of a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001; See also MPEP 2700. However, the filing of drawings after the mailing of a Notice of Allowance is properly a basis for reduction of patent term adjustment.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that rather than file an argument that the Notice was in error, patentee filed drawings after the mailing of the Notice of Allowance. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Filing of any drawings after allowance will be treated as a failure to engage in reasonable efforts to conclude prosecution.

Furthermore, patentee does not dispute that Figures 1 and 2 were properly labeled as "(Prior Art)." Rather, patentee asserts that the examiner was without authority to make such a request. In this regard, patentee's attention is directed to MPEP 608.02(g). This provision provides that:

Figures showing the prior art are usually unnecessary and should be canceled. Ex parte Elliott, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

In order to avoid this failure to engage in reasonable efforts to conclude prosecution of the application, patentee should have filed formal drawings in compliance with MPEP 608.02(g) prior to the mailing of the notice of allowance. The drawings filed September 8, 2003 were formal but did not include the Prior Art labels.

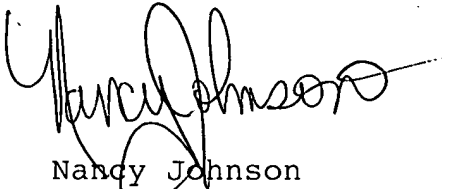
Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by the lesser number of days, 120, counting the number of days in the period beginning on the date the drawings were filed, February 25, 2005, and ending on the date of issuance of the patent, June 28, 2005.

In view thereof, the reduction of 120 days was proper

It is concluded that the patent properly issued with a revised Patent Term Adjustment of eleven (11) days.

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized flourish extending from the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions